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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

PREBILIC, PAUL B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3738

DATE MAILED: 01/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/418,505 | KANIA ET AL. | |
| | Examiner | Art Unit | |
| | Paul B. Prebilic | 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 22, 23 and 29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18 and 19 is/are allowed.
- 6) ☒ Claim(s) 16, 17, 23-28 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8, 4, 6</u> | 6) <input type="checkbox"/> Other: _____ |

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Election/Restrictions

Claims 1-15, 21, 22, and 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11 filed December 14, 2001. The traversal is on the ground(s) that there is no additional burden of search. This is not found persuasive because searching the gel composition would at least additionally require searching class 516. Moreover, searching for the other species would require additional time and would make examination more burdensome also.

The requirement is still deemed proper and is therefore made FINAL.

Inventorship

In view of the papers filed March 3, 2000, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding Christopher Kelly as the sixth inventor.

The application has been forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data has been made to reflect the inventorship as corrected.

Specification

The abstract of the disclosure is objected to because it is too concise and fails to adequately describe the invention. Correction is required. See MPEP § 608.01(b).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The disclosure is objected to because of the following informalities:

On page 9 of the specification, the description of Figures 2 and 3 does not match the figure in that "(A)", "(B)", "a", and "b" are not shown in the drawings.

On page 12, line 16, this line appears to be missing some text and the language of this line does not grammatically match the line thereafter.

The use of the trademarks VELCRO (throughout) and POLARTEC (page 38, line 18) has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the covering fabric, the docking means for suspension of the covering, and the docking means for attaching pads must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 30, there is no clear support for "covering fabric that can adhere to a hook portion of a hook and loop fastening system." Rather, a band is attached to itself not the fabric covering; see Figure 16 and page 27 of the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24, 25, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 24, the claim language "docking means for suspension of the covering to the wearer" appears to lack antecedent basis from the specification such that it is not clear what element thereof is being discussed. For this reason, the Examiner will interpret this language as referring to Figure 9 and similar structures of the specification.

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With regard to claim 25, the language "docking means for attaching pads" lacks antecedent support from the specification and it is unclear what element(s) of the specification are being referred to. For this reason, the Examiner will interpret claim 25 as referring to structures such as those shown in Figure 9.

With regard to claim 30, assuming that original implicit support can be found for the subject matter set forth herein, the Examiner notes that there is no clear antecedent basis from the specification for the subject matter of this claim.

Claim 26 is objected to because of the following informalities: On line 2 of claim 26, ---opposite--- is misspelled. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24 and 25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 81 and 82 of copending Application No. 09/121,300. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because the present claims are more specific than the copending claims but claims 81 and 82 read thereon such that the present claims are clearly obvious in view thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 16, 17, 23-25, 27, and 30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kania (US 5,830,237); see the whole document, especially Figures 9 and 11.

With regard to claims 16 and 17, the elastic fabric of Kania is wear resistant and highly elastic to the extent that these terms can be given patentable weight due to the

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relativity. For this reason, even if the same fabric were used for both the pieces of fabric, the claim language would be fully met because the some of the fabrics have both claimed properties to some degree.

With regard to claim 30, the Examiner posits that at least the terry fabrics can adhere to hook and loop fasteners because they have loops on the surface. Other fabrics disclosed have this property to some extent, but terry fabric appears to be the best of the disclosed fabrics; see Example 7 of Kania.

Claim 23 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kania (US 5,603,122); see the whole document.

Claims 23 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Lerman (US 4,832,010); see the whole document, especially Figures 6 and 7 where fabric on the inner and outer polymer material surface reads on the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lerman (US 4,832,010) in view of Laghi (US 5,507,834). Lerman meets the claim language but does not disclose the use of a thermal-regulating additive as claimed. Laghi, however, teaches that it was known to use silica fillers in similar coverings in order to improve the

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viscosity of the polymeric material. Since this additive would also change the thermal properties of the polymeric material because it would make it denser, the Examiner asserts that the silica fillers are thermal-regulating additives to the extent that this terminology can be given weight. Hence, it is the Examiner's position that it would have been obvious to add silica fillers to the Lerman polymeric material in order to improve the viscosity thereof and for the other reasons that Laghi does the same.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lerman (US 4,832,010) in view of Kristinsson et al (US 6,136,039). Lerman meets the claim language except for the metal coating on the outside as claimed. Kristinsson et al teaches that it was known to use docking means, which are usually made of metal, to the outside of similar covering devices. Since coatings are denoted in dictionaries to encompass coverings, the docking means of Kristinsson et al constitutes a coating. Hence, it is the Examiner's position that it would have been obvious to add a docking means, or metal coating, to the Lerman device in order to facilitate its secure attachment to a leg prosthesis.

Allowable Subject Matter

Claims 18 and 19 are allowed over the prior art of record.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure

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outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned problem is corrected.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic
Primary Examiner
Art Unit 3738